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EXAMINER

YANG, RYAN R

ART UNIT	PAPER NUMBER
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2672

DATE MAILED: 05/19/2004

10

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/826,398

Applicant(s)

SANGER, TERENCE DAVID

Examiner

Ryan R Yang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 21 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 4,5,7,9-13 and 19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 4,5,7,9-13 and 19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. This action is responsive to communications: Amendment, filed on 8/21/2003.

This action is non-final.

2. Claims 4, 5, 7, 9-13 and 19 are pending in this application. Claims 4, 5, 7, 9 and 19 are independent claims. In the Amendment, filed on 8/21/2003, claims 4, 5, 7 and 9 were amended, claims 1-3, 6, 8 and 14-18 were canceled, and claims 19 were added.

3. This application claims benefit of 60/194,347 dated 04/03/2000.

4. The present title of the invention is "Method and apparatus for sending electronic mail using human handwriting" as filed originally.

### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claim 7 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 7 limitation about baseline is not described in specification.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Powers (6,446,115) and further in view of Admitted Prior Art.

As per claim 4, Powers discloses a method for generating an electronic mail message containing simulated handwriting, comprising the steps of:

accessing a website having a user interface (Figure 1 10 WWW Server);

entering a text message through the user interface (Figure 1 17 Composition Server);

creating a graphic image of simulated handwriting that corresponds to the text message ("Once the correspondence has been created with the text of the email message along with template information from the database (such as a letterhead), a graphical representation of the correspondence is sent to the sender for review", column 18, line 13-16); and

specifying one or more formatting parameters (Figure 3B 41 Determine size, type, format ...);

wherein the specifying step includes choosing a pen type (Figure 3B 41 Determine size, type ...).

It is noted that Power does not explicitly disclose "the pen types include ballpoint, felt-tip and calligraphic", however, this is known in the admitted prior art (Specification, page 1, line 29).

Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of admitted prior art into Powers in order to the e-mail message more personal.

9. Claims 5, 9, 10 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Powers (6,446,115) and further in view of Roy (5,327,342).

As per claim 5, Powers discloses a method for generating an electronic mail message containing simulated handwriting, comprising the steps of:

- accessing a website having a user interface (Figure 1 10 WWW Server);
- entering a text message through the user interface (Figure 1 17 Composition Server);

- creating a graphic image of simulated handwriting that corresponds to the text message ("Once the correspondence has been created with the text of the email message along with template information from the database (such as a letterhead), a graphical representation of the correspondence is sent to the sender for review", column 18, line 13-16); and

- specifying one or more formatting parameters (Figure 3B 41 Determine size, type, format ...).

Powers discloses a method of generating an electronic mail of handwriting. It is noted that Powers does not explicitly disclose the specifying step includes a degree of

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messiness, however, this is known in the art as taught by Roy. Roy discloses a method of generating personalized handwriting where the randomness of spacing between character strings can be selected (Figure 5 86 and column 6, line 25-45, when the spacing looks random the handwriting looks messy).

Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Roy into Powers because Powers disclose discloses a method of generating handwriting transportable by electronic mail and Roy discloses the spacing between the character strings can be randomly space in order to make the handwriting look more personal.

10. As per claim 9, Powers discloses a method for generating an electronic mail message containing simulated handwriting, comprising the steps of:

- accessing a website having a user interface (Figure 1 10 WWW Server);

- entering a text message through the user interface (Figure 1 17 Composition Server);

- creating a graphic image of simulated handwriting that corresponds to the text message ("Once the correspondence has been created with the text of the email message along with template information from the database (such as a letterhead), a graphical representation of the correspondence is sent to the sender for review", column 18, line 13-16); and

- specifying one or more formatting parameters (Figure 3B 41 Determine size, type, format ...);

wherein the specifying step includes choosing a handwriting script (Figure 3B 41 Determine ... signature for letter from data).

Powers discloses a method of generating an electronic mail of handwriting. It is noted that Powers does not explicitly disclose "wherein the creating step includes: accessing a database containing the chosen handwriting script; selecting letter shapes from the handwriting script database that correspond to the text message; joining the letters shapes; drawing the strokes to create the graphic image", however, this is known in the art as taught by Roy. Roy discloses a method of generating simulated handwriting in which the dictionary (Figure 1 14) is the database; "The words in the document are compared to a list of the graphical images in the dictionary. Words that are in the dictionary are replaced with the associated graphical image" (column 2, line 45-48); words and letters are joined (Figure 6a-6e and "The head describes how that image should be joined with an image placed adjacent and to the left. The tail describes how the image should be joined with an image placed adjacent and to the right", column 6, line 53-56); and the graphic image is drawn ("The resulting sequence is replaced with a sequence of associated graphical images and modified to formed a contiguous word image", column 2, line 50-53).

Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Roy into Powers because Powers discloses a method of generating an electronic mail of handwriting and Roy discloses the different styles of handwritten image can be created in order to make it look more personal.

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11. As per claim 10, Powers and Roy demonstrated all the elements as applied to the rejection of independent claim 9, supra, and Powers further discloses the graphic image is a high-resolution image ("each sender can register multiple preferences for a single field ... Such high resolution and original source files will be of varying format and resolution", column 8, line 6-10).

12. As per claim 19, Powers discloses a system for generating an electronic mail message containing simulated handwriting, the system comprising:

an input to receive a text message from a user over a network (Figure 1 Email Server 11);

means for converting the text message into the electronic mail message ("Once the correspondence has been created with the text of the email message along with template information from the database (such as a letterhead), a graphical representation of the correspondence is sent to the sender for review", column 18, line 13-16); and

and output to transmit the electronic mail message to the user (Figure 1 Operation Server 13).

Powers discloses a method of generating an electronic mail of handwriting. It is noted that Powers does not explicitly disclose "the means for converting including means for selecting letter shapes that corresponding the text message and means for joining the letter shapes to create the text message", however, this is known in the art as taught by Roy. Roy discloses a method of generating simulated handwriting in which "The words in the document are compared to a list of the graphical images in the



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dictionary. Words that are in the dictionary are replaced with the associated graphical image" (column 2, line 45-48); words and letters are joined (Figure 6a-6e and "The head describes how that image should be joined with an image placed adjacent and to the left. The tail describes how the image should be joined with an image placed adjacent and to the right", column 6, line 53-56; "The resulting sequence is replaced with a sequence of associated graphical images and modified to formed a contiguous word image", column 2, line 50-53).

Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Roy into Powers because Powers discloses a method of generating an electronic mail of handwriting and Roy discloses the different styles of handwritten image can be created in order to make it look more personal.

13. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Powers (6,446,115) and further in view of Baird (5,796,410).

As per claim 7, Powers discloses a method for generating an electronic mail message containing simulated handwriting, comprising the steps of:

accessing a website having a user interface (Figure 1 10 WWW Server);

entering a text message through the user interface (Figure 1 17 Composition Server);

creating a graphic image of simulated handwriting that corresponds to the text message ("Once the correspondence has been created with the text of the email message along with template information from the database (such as a letterhead), a

graphical representation of the correspondence is sent to the sender for review",  
column 18, line 13-16); and

specifying one or more formatting parameters (Figure 3B 41 Determine size,  
type, format ...).

Powers discloses a method of generating an electronic mail of handwriting. It is noted that Powers does not explicitly disclose the specifying step includes choosing between a wandering text baseline and a straight text baseline, however this is known in the art as taught by Baird. Baird discloses a method of generating a character image in which it can be offset from a baseline (Abstract, line 2-5).

Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Baird into Powers because Powers disclose discloses a method of generating handwriting transportable by electronic mail and Baird discloses the characters can be offset from a baseline in order to make a more personal handwriting.

14. Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Powers (6,446,115), Roy and further in view of Lavery et al. (6,353,483).

As per claim 11, Powers and Roy demonstrated all the elements as applied to the rejection of dependent claim 10, supra.

Powers and Roy disclose a method of generating an electronic mail of handwriting. It is noted that Powers and Roy do not explicitly disclose the step of reducing the high-resolution image to a more compact low-resolution image through an anti-aliasing procedure, however, this is known in the art of Lavery et al., hereinafter,

Lavery. Lavery discloses a method of converting a high-resolution image (Postscript) to low-resolution image (bitmap) using anti-aliasing method (column 6, line 22-25).

Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Lavery into Powers and Roy because Powers and Roy disclose a method of generating an electronic mail of handwriting and Lavery discloses the original high-resolution image can be converted to low-resolution image in order to display it.

15. As per claim 12, Powers, Roy and Lavery demonstrated all the elements as applied to the rejection of dependent claim 11, *supra*, and Lavery further discloses the step of reviewing the low-resolution image ("It simply provides a low-resolution file for display", column 5, line 22).

Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Lavery into Powers and Roy because Powers and Roy disclose a method of generating an electronic mail of handwriting and Lavery discloses the original high-resolution image can be converted to low-resolution image in order to display it.

16. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Powers (6,446,115), Roy, Lavery and further in view of Cheng et al. (6,012,070).

As per claim 13, Powers, Roy and Lavery demonstrated all the elements as applied to the rejection of dependent claim 12, *supra*.

Powers, Roy and Lavery disclose a method of generating an electronic mail of handwriting. It is noted that Powers, Roy and Lavery do not disclose sending electronic

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mail in low resolution, however, this is known in the art as taught by Cheng et al., hereinafter Cheng. Cheng discloses a method of send electronic mail in which low-resolution image is transmitted (Abstract, "low resolution graphics templates ... may be electronically or otherwise transmitted to a printing installation without the necessity of transmitting a final document with high resolution color graphics in physical form").

Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Cheng into Powers, Roy and Lavery because Powers, Roy and Lavery disclose a method of generating an electronic mail of handwriting and Cheng the image can be transmitted in lower resolution on order to save bandwidth.

### ***Response to Arguments***

17. Applicant's arguments with respect to claims 4, 5, 7 and 9 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

### ***Inquiries***

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Ryan Yang** whose telephone number is **(703) 308-6133**.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Michael Razavi**, can be reached at **(703) 305-4713**.

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks


Washington, D.C. 20231

**or faxed to:**

**(703) 872-9314 (for Technology Center 2600 only)**

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 305-47000377.

  
Ryan Yang  
May 14, 2004